

**Notice of Allowability**

Application No.

10/749,098

Examiner

Michelle R. Connelly-Cushwa

Applicant(s)

HAYASHI, KENICHI

Art Unit

2874

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to \_\_\_\_.
2. ☒ The allowed claim(s) is/are 1-14.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of the:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☒ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_.
- (b) ☒ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date 1105.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |  |   |
|--|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)           |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                               | 6. <input type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date ____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),<br>Paper No./Mail Date ____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment                   |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material         | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance  |
|  | 9. <input type="checkbox"/> Other ____.   |

## **DETAILED ACTION**

### **EXAMINER'S AMENDMENT**

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Lawrence J. McClure on November 10, 2005.

The application has been amended as follows:

Claims 15-20 have been cancelled.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14, drawn to a manufacturing method for an optical element, classified in class 385, subclass 147.
- II. Claims 15-20, drawn to an optical element, classified in class 385, subclass 147.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another

Art Unit: 2874

and materially different process, because the product as claimed does not require an inspection groove. The Examiner notes that claim 15 defines "an inspection groove" in line 3 of the claim, but further states "the inspection groove being cut out" in the last line of the claim, indicating that there is not an inspection groove present in the final optical element. Claim 15 is a product-by-process claim, and the process limitations thereof are not given patentable weight. Therefore, the final optical element of claim 15 may be made by a method that does not include the formation of a inspection groove, since there is not an inspection groove present in the finished optical element.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Lawrence J. McClure on November 10, 2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-20 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

This application is in condition for allowance except for the presence of claims 15-20 to an invention non-elected without traverse. Accordingly, claims 15-20 have been cancelled.

### ***Drawings***

The drawings are objected to because the lines and reference numbers are blurred. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in

Art Unit: 2874

reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Allowable Subject Matter***

Claims 1-14 are allowed.

The following is an examiner's statement of reasons for allowance: The prior art cited on attached form PTO-892 is the most relevant art known, however, the invention of claims 1-14 distinguishes over the prior art of record for the following reasons.

Regarding claims 1-7; the claims are allowable over the prior art of record because none of the references either alone or in combination disclose or render obvious a manufacturing method for an optical element comprising: forming an inspection groove on a surface of the base member by the blade tip part of the cutting tool; inspecting an inclination of a cut surface of the inspection groove formed by the cutting tool to form an inspection result; correcting an angle defined by the base member and the blade tip part of the cutting tool based on the inspection result; and forming a second groove on the surface of the base member having the inspection groove simultaneously with the inspection groove being cut out in combination with the other limitations of claim 1. Claims 2-7 depend from claim 1.

Regarding claims 8-14; the claims are allowable over the prior art of record because none of the references either alone or in combination disclose or render obvious a manufacturing method for an optical element comprising: forming an inspection groove on a surface of the base member by the blade tip part of the cutting tool; inspecting an inclination of a cut surface of the inspection groove formed by the cutting tool to form an inspection result; correcting an angle defined by the base member and the blade tip part of the cutting tool based on the inspection result; and forming a second groove on the base member having the inspection groove simultaneously with the inspection groove being cut out in combination with the other limitations of claim 8. Claims 9-14 depend from claim 8.

Hence, there is no reason or motivation for one of ordinary skill in the art to use the prior art of record to make the invention of claims 1-14.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

Any inquiry concerning the merits of this communication should be directed to Examiner Michelle R. Connelly-Cushwa at telephone number (571) 272-2345. The examiner can normally be reached 9:00 AM to 7:00 PM, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney B. Bovernick can be reached on (571) 272-2344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general or clerical nature should be directed to the Technology Center 2800 receptionist at telephone number (571) 272-1562.

*Michelle R. Connelly-Cushwa*  
Michelle R. Connelly-Cushwa  
Patent Examiner  
November 11, 2005